



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Burke et al

Serial No. 09/998,718  
Conf. No. 7192

Filed: November 1, 2001

For: METHODS AND COMPOSITIONS FOR  
TREATMENT OF OCULAR NEOVASCULARIZATION  
AND NEURAL INJURY

Group Art Unit: 1614

Examiner: Fay, Z.

Docket No. 17400-IP(EPAR)

TECH CENTER 1600/2900

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REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Alexandria, VA 22313-1450

Dear Sir,

Applicants are in receipt of a Restriction Requirement in the present case, in which claims 1-12 have been characterized as pertaining to a method for reducing or eliminating a decrease in a neurosensory retinal function using an alpha-receptor agonist, and claims 13-25 have been characterized as being drawn to a methods of protecting ocular neural tissues using an alpha-adrenergic agonist. Applicants respectfully traverse this requirement.

Independent claim 1 is actually drawn to a method of reducing or eliminating a decrease in a neurosensory retinal function (i.e., protecting retinal neurons from damage) following laser irradiation of the retina, which involves the use of an alpha agonist as a neuroprotectant.

Independent claim 13 is drawn to a method of protecting ocular neural tissues from damage caused by electromagnetic radiation (e.g., laser damage) by administering a neuroprotectant to such tissues. In dependent claims only is the neuroprotectant indicated as an alpha agonist.

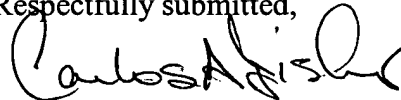
When read as a whole it can be seen that both claim sets are drawn to aspects of the same invention. An alpha agonist is a specific neuroprotectant, just as laser radiation is a specific form of electromagnetic radiation and retinal cells a specific form of ocular nerve cell. Nevertheless, the same elements are present in each independent claim – prospective damage caused to ocular nerve cells by electromagnetic radiation, and treatment of the nerve tissue with a neuroprotectant to decrease the damage otherwise caused.

The Examiner has stated that "each of the above groups is directed to the treatment of totally different conditions." Office Action at page 2. However, as can be seen from the explanation above, this is clearly not the case. Claims 1-12 are special cases of claim 13. For this reason, Applicants respectfully believe that there is no serious burden on the Examiner to conduct an examination of both claim sets, and respectfully request the Examiner's reconsideration of the restriction requirement.

In the event that the Restriction Requirement is made final, Applicants elect to proceed with prosecution of claims 13-25, and therefore provisionally direct the withdrawal of claims 1-12. These elections are without prejudice to Applicants' right to petition the Commissioner, or to take any other action in order to reverse any such finality.

Should any fee be due in connection with this communication kindly use Deposit Account 01-0885 for the payment thereof.


Respectfully submitted,



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CERTIFICATE OF MAILING

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Date: 6/24/2003